

REMARKS

Reconsideration and allowance of the above-identified patent application are respectfully requested in view of the remarks that follow.

By this Amendment, claims 1, 10-13 and 22-24 have been canceled. Claims 2, 3, 5, 8, 9, 14-17, 19, and 20 have been amended to recite proper dependency from the remaining claims. In addition, claims 21 and 25 have been amended to recite the phrase “at least x%” rather than “at least about x%”.

Claims 1-6, 8-21, 22-24 and 25-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

It is the Examiner’s position that the term “at least about” is confusing. Without prejudice to the further prosecution of this application, and other related and unrelated applications, applicants have amended claims 21 and 25 to recite the phrase “at least x%” rather than “at least about x%”. It is submitted that the rejection has been obviated by the amendment of the claims.

Accordingly, is respectfully requested that rejections under 35 U.S.C. 112, second paragraph, be withdrawn.

Claims 1-6, 8-18, 20 and 22-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farina, et al., in view of Daddona, et al., and common knowledge in the art as exemplified by Dessouki, et al.

Applicants respectfully rely on their arguments presented in the Response filed on August 9, 2007 and incorporate those arguments by reference as if set out in full in the present Response. Applicants acknowledge, with appreciation, the Examiner’s observation of the clerical error on page 7, line 7, of Applicant’s Response filed on August 9, 2007 in which the effective filing date of March 4, 2003 was incorrectly recited as February 26, 2004.

Claims 19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farina, et al., in view of Daddona, et al., and common knowledge in the art as exemplified by Dessouki, et al. and Beach, et al.

It is respectfully submitted that although the Examiner has identified certain disclosures in each of the four cited references to support the rejection of the claims, the Patent and Trademark Office has failed to meet its burden in establishing a prima facie case of obviousness because it has failed to provide a sound basis to combine the references in the manner suggested.

The Supreme Court recently addressed the issue of obviousness in KSR International Co. v. Teleflex Inc., 127 S. Ct. 1727 (2007). The Court stated that the Graham v. John Deere Co. of Kansas City, 383 U.S. 1 (1966), factors still control an obviousness inquiry. Those factors are: 1) “the scope and content of the prior art”; 2) the “differences between the prior art and the claims”; 3) “the level of ordinary skill in the pertinent art”; and 4) objective evidence of nonobviousness. KSR, 127 S. Ct. at 1734 (quoting Graham, 383 U.S. at 17-18).

Each test for prima facie obviousness applied by the Patent Office, e.g., the “differences between the prior art and the claims”; must be consistent with the legal principles enunciated in KSR. While the KSR Court rejected a rigid application of the teaching, suggestion, or motivation (“TSM”) test in an obviousness inquiry, the Court acknowledged the importance of identifying “a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does” in an obviousness determination. KSR, 127 S. Ct. at 1731. Moreover, the Court indicated that there is “no necessary inconsistency between the idea underlying the TSM test and the Graham analysis.” Id. As long as the test is not applied as a “rigid and mandatory” formula, that test can provide “helpful insight” to an obviousness inquiry. Id. Thus, in cases involving new methods, it remains necessary to identify some reason that would have led a chemist to modify a known process in a particular manner to establish prima facie obviousness of a new claimed method.

Applicants respectfully request that the Examiner reconsider the patentability of the invention and withdraw the rejection of the currently pending claims under 35 U.S.C. 103(a).

The application now contains one independent claim and a total of 17 claims. The Commissioner is hereby authorized to charge any additional fees under 37 C.F.R. 1.17 which may be required, or credit any overpayment, to Account No. 19-3880 in the name of Bristol-Myers Squibb Company.

Respectfully submitted,



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